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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	78514746
Applicant	HONDA MOTOR CO., LTD.
Applied for Mark	RL
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Date	08/29/2007

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Application Serial No.: 78/514,746

Trademark: **RL**

Applicant: **HONDA MOTOR CO., LTD.**

APPLICANT’S REPLY BRIEF

We do not disagree with the “Facts” (to the extent they are stated). We disagree with the statement that whether there is a likelihood of confusion between RL and RL-CLASS for the same goods is the “sole issue” on appeal. Whether the fact that the Office already has determined that there is not likelihood of confusion between the two marks (actually one of the marks and a surrogate of the other) owned by the same two parties also merits consideration is an issue on this appeal.

We also disagree with the proposition that a body of law that repeatedly minimizes the significance and weight of “third party” registrations controls the outcome here. There is no “third party” registration involved here. There are applications and registrations of marks of only two parties involved in this appeal – Honda (3.5RL and RL) and DaimlerChrysler (RL-CLASS). We don’t disagree that “each case must be decided on its own merits based on the evidence of record,” *In re Sunmarks, Inc.*, 32 USPQ2d at 1472, but the facts and record in this case and when RL-CLASS was approved and registered are scant – the mark and the goods in an existing registration and in an application. *In re International Taste* recognizes that “the Office strives for consistency.” 53 USPQ2d at 1606. Here, the Office appears to be going out of its way to avoid not only consistency, but fairness and equality, between the same two parties in two sequential instances.

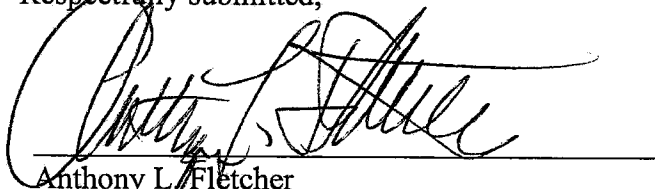
As the Examining Attorney points out, “if the registrant’s mark had not included a hyphen separating RL from CLASS the registrant would have been required to disclaim the word CLASS as being descriptive.” If that is correct, and it seems to be, then if the applicant’s earlier registration had not fused 3.5 with RL to create the solitary alpha-numeric designation 3.5RL, then applicant would have been required to disclaim the numbers 3.5 as being descriptive. The only part of either 3.5RL or RL-CLASS that is inherently distinctive is the element they have in common -- RL, yet the Office permitted both to coexist on the Register. Was this a mistake? The Office apparently didn’t think so at the time, probably because it felt that the word CLASS gives RL-CLASS a decidedly different appearance, sound and meaning than is given by 3.5RL (or by RL – 3.5 is about as distinctive as a shoe size – it is obviously and, to anyone familiar with automobiles blatantly, a measure of some capacity of the car).

The Examining attorney’s position is expressly stated to be “that prior decisions and actions of other trademark attorneys in registering different marks are without evidentiary value and are not binding upon the Office.” That they are not “binding” is simple wisdom – it is wiser not to be bound by past mistakes (if one can avoid them). But that they are without “evidentiary value,” (which apparently means they don’t exist for present purposes) is the antithesis of wisdom. The American legal system is built on precedent, which is a respectful consideration of what was decided in the past, and a departure from it only after reasonably careful consideration. Mistakes should not be retreated. Not all the past is mistaken, and in the present case, the Examining Attorney should be compelled, at the very least, to weigh (rather than ignore) the earlier decision involving the marks of the two parties, and justify any departure from that earlier decision.

What is strikingly wrong about the Examiner's decision below is the result. If the decision is correct, the prior user and registrant of RL for automobiles (in the form 3.5RL, the only independently registrable component of which is RL) is prohibited from registering RL by an intervening registration of RL-CLASS. To say that RL-CLASS is distinguishable from 3.5RL but RL is not distinguishable from RL-CLASS defies common sense.

Dated: August 29, 2007

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Anthony L. Fletcher", is written over a horizontal line.

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